

Applicant: EBERLE *et al.*  
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### **REMARKS**

In response to the Non-Final Office Action mailed April 21, 2006 (hereinafter "Office Action"), claim 11 has been amended. No claims have been cancelled or newly added. Therefore, claims 1-20 remain pending. Support for the instant amendment is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendment and following comments, allowance of all the claims pending in the application is respectfully requested.

### **INFORMATION DISCLOSURE STATEMENT**

Applicants thank the Examiner for considering the references cited in the two *electronic* Information Disclosure Statements and the Supplemental Information Disclosure Statement filed on February 9, 2006, as evidenced by the signed and initialed copies of the PTO-1449 forms returned with the Office Action.

Applicants are submitting herewith a Supplemental Information Disclosure Statement and respectfully request that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

### **REJECTIONS UNDER 35 U.S.C. § 101**

Claims 11-20 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner alleges that the aforementioned claims "*merely manipulate an abstract idea without a claimed limitation to a practical application*" [Office Action, pg. 2, ¶4]. Applicants traverse this rejection for *at least* the reason that the

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Examiner is improperly reading limitations into 35 U.S.C. § 101 on the subject matter that may be patented.

The Court of Appeals for the Federal Circuit has stated that “it is improper to read limitations into Section 101 on the subject matter that may be patented...that Congress clearly did not intend...” *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) In that case, the court stated that the transformation of data at issue, constituted a practical application (and thus directed towards statutory subject matter), because “it produc[ed] a useful, concrete, and tangible result...” *Id.* (internal quotes omitted).

The subject matter of claims 11-20 are directed to statutory subject matter because, as in *State St.*, these claims produce “a useful, concrete, and tangible result.” For example, among other things, the invention of independent claim 11 (and dependent claims 12-20) selects at least one of a plurality of voice messages to deliver to a voice service subscriber based on other data (*e.g.*, based on a voice input command received from the voice service subscriber during an interactive voice broadcast). Delivery of a voice message to a voice service subscriber, based on a voice input command received from the voice service subscriber, represents a useful, concrete, and tangible result.

For *at least* the foregoing reasons, the rejection of claims 11-20 under 35 U.S.C. § 101 is legally improper and should be withdrawn.

#### **NON-STATUTORY DOUBLE PATENTING REJECTION**

Claims 1-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 6,885,734 to Eberle *et al.* (“Eberle”) in view of U.S. Patent No. 5,721,827 to Logan *et al.*

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(“Logan”) [Office Action, pg. 6, ¶6]. Applicants disagree with the rejection set forth by the Examiner. However, *solely* in an effort to expedite prosecution, a terminal disclaimer is being filed herewith. Applicants note that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d (BNA) 1392 (Fed. Cir. 1991). The court indicated that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.” Accordingly, withdrawal of this rejection is earnestly sought.

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**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: August 21, 2006

Respectfully submitted,

By:

  
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## Addendum

### Attachment 1

SYSTEM AND METHOD FOR VOICE-ENABLED INPUT FOR USE IN THE  
CREATION AND AUTOMATIC DEPLOYMENT OF PERSONALIZED, DYNAMIC,  
AND INTERACTIVE VOICE SERVICES